

REMARKS

1. Summary of the Office Action

In the office action mailed January 9, 2008, (i) the Examiner rejected claim 25 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement, and (ii) the Examiner rejected claims 1, 2, 5-11, 13-18, and 22-25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,740,549 A (hereinafter "Reilly").

2. Amendments and Status of the Claims

Applicant has amended claims 1 and 20, and added new claims 26-28. Claims 1, 2, 5-11, 13-18, 20, and 22-28 are pending. Claims 1 and 20 are independent.

Support for the amendments to claims 1 and 20 is located in the specification, for example, at (i) page 7, third full paragraph, lines 1-4, (ii) page 10, second full paragraph, lines 2-12, and (iii) page 20, last paragraph, lines 1-8. Support for new claim 26 is located in the specification, for example, at page 3, fifth paragraph, lines 3-8. Support for new claims 27 and 28 is located in the specification, for example, at page 6, second paragraph, lines 6-8.

3. Response to Rejection under 35 U.S.C. § 112

The Examiner rejected claim 25 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner indicated that claim 25 contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. In particular, the Examiner indicated that (i) it appears that the specification does not immediately support that the video replay system is a

handheld video player, and (ii) the specification does not clearly support displaying content on the screen of a portable, wireless, handheld or mobile device.

Claim 25 recites “wherein the video replay system is a handheld video player.” Applicant submits that the specification provides support for claim 25. For example, the second paragraph of the detailed description of preferred embodiments on page 5 of the specification states, *inter alia*, “[t]he described advertising system is preferably located in a device such as a video replay system, (for example, a video replay system sold by Replay TV, Inc. of Mountain View, Calif.), although the present invention can be used with other devices, including ***other video replay systems, including but not limited to*** interactive TV, set-top applications and devices, and ***handheld video players.***” Because the specification clearly supports claim 25, Applicant respectfully requests that the Examiner withdraw the rejection of claim 25 under 35 U.S.C. § 112, first paragraph.

4. Response to Rejections under 35 U.S.C. § 103

The Examiner rejected claims 1, 2, 5-11, 13-18, and 22-25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Reilly. Of these claims, 1 and 20 are independent. Independent claims 1 and 20, as amended, patentably distinguish over Reilly.

At a minimum, Reilly does not reasonably lead to (i) while the user selected program content is being displayed on the display of the video replay system, entering a pause mode in response to a user action that comprises pressing a pause key, (ii) upon entering the pause mode, pausing the user selected program content and displaying the paused user selected program content on the display of the video replay system during a time delay greater than zero seconds, and (iii) after the time delay has elapsed, displaying the ad on the display of the video replay system, as recited in amended claims 1 and 20.

First, in rejecting the claims, as far as Applicant can tell, the Examiner argued that the “news items” disclosed by Reilly amount to “paused content.” (See, office action, page 6, first full paragraph, lines 1-2). Claims 1 and 20, as amended in an amendment filed December 21, 2007, recite “paused content.” However, claims 1 and 20, as currently amended, now recite “paused user selected program content” instead of “paused content.”

In rejecting the claims, the Examiner also indicated that Reilly discloses that a predefined idleness criteria could be the failure to receive any input for a period of at least five minutes. (See, office action, page 5, first paragraph, lines 3-5). As far as Applicant can tell, the Examiner then argued that the “predefined idleness criteria” amounts to “entering a pause mode in response to a user action.” (See, office action page 5, first paragraph, lines 3-5). In support of this argument, (i) the Examiner argued that the user action includes the action or inaction of not issuing any input to a computer to thereby trigger the display of the selected program content and advertisements during an idle time or pause mode, and (ii) the Examiner cited to Reilly, col. 2, lines 28-34. (See, office action, page 5, lines 5-8).

For the sake of argument, Applicant assumes that the “predefined idleness criteria” amounts to “entering a pause mode in response to a user action that comprises pressing a pause key.” However, even if this assumption is correct, which Applicant does not concede, Reilly does not reasonably lead to entering the pause mode while the user selected program content is being displayed on the display of the video replay system, and upon entering the pause mode, pausing the user selected program content and displaying the paused user selected program content on the display of the video replay system during a time delay greater than zero seconds, as recited in claims 1 and 20.

On the contrary, Reilly discloses that the display of news items (i.e., “paused content” according to the Examiner) and advertisements begins when the predefined idleness criteria is met. For example, col. 2, lines 30-34 and col. 11, lines 43-49 of Reilly disclose that (i) whenever the system detects a lack of user inputs via either a keyboard or pointer device (e.g., a mouse or trackball) for a user configurable or otherwise specified length of time (e.g., 5 minutes), the screen saver procedures of the present invention ***begin the display of news items*** and advertisements from the local information database, and (ii) information and advertisements are automatically displayed when a subscriber’s computer is on but meets predefined idleness criteria (e.g., the failure to receive any input for a period of five minutes). However, merely beginning to display news items (“paused content” according to the Examiner) and advertisements when a predefined idleness criteria is met does not reasonably lead to (i) while the user selected program content is being displayed on the display of the video replay system, entering a pause mode in response to a user action that comprises pressing a pause key, (ii) upon entering the pause mode, pausing the user selected program content and displaying the paused user selected program content on the display of the video replay system during a time delay greater than zero seconds, and (iii) after the time delay has elapsed, displaying the ad on the display of the video replay system, as recited in amended claims 1 and 20.

Next, as indicated above, Applicant does not concede the assumption that the “predefined idleness criteria” disclosed by Reilly amounts to “entering a pause mode in response to a user action that comprises pressing a pause key.” At best, Reilly discloses that (i) the predefined idleness criteria occurs whenever a system detects ***a lack of user inputs*** via either a keyboard or pointer device (e.g., a mouse or trackball) for a user configurable or otherwise specified length of time (e.g., 5 minutes), and (ii) the predefined idleness criteria could be the ***failure to receive any input*** for a period of at least five minutes. Applicant submits, however, that ***a lack of user inputs via either a***

keyboard or pointer device and/or a *failure to receive any input* for a period of at least five minutes does not amount to *a user action that comprises pressing a pause key*, as recited in claims 1 and 20.

Next, as indicated above, the Examiner cited to column 2, lines 28-34 of Reilly in support of an argument that a “predefined idleness criteria” amounts to the claimed “entering a pause mode in response to a user action.” This portion of Reilly states, “[i]t is a goal of the present invention to disseminate information and advertisements to subscribers’ computers in a system where the information and advertisements are automatically displayed when the subscriber’s computer is on but meets predefined idleness criteria. For example, the predefined idleness criteria could be the *failure to receive any input* for a period of at least five minutes.” (Emphasis added).

For the sake of argument, Applicant assumes that the “failure to receive any input” amounts to a user action and/or a user inaction. However, even if this assumption is correct, which Applicant does not concede, the “predefined idleness criteria” disclosed by Reilly does not amount to entering a pause mode *in response to* a user action. As disclosed by Reilly, the predefined idleness criteria *could be* the failure to receive any input for the period of at least five minutes, whereas the pause mode, recited in claims 1 and 20, is *entered in response to* a user action, and in particular, *entered in response to* a user action comprising pressing a pause key.

For at least these reasons, Reilly does not reasonably lead to (i) while the user selected program content is being displayed on the display of the video replay system, entering a pause mode in response to a user action that comprises pressing a pause key, (ii) upon entering the pause mode, pausing the user selected program content and displaying the paused user selected program content on the display of the video replay system during a time delay greater than zero seconds, and (iii) after the time delay has elapsed, displaying the ad on the display of the video replay system, as recited in amended claims 1 and 20.

Because Reilly fails to reasonably lead to the invention recited in claims 1 and 20, Applicant submits that claims 1 and 20 are allowable. Further, without conceding the assertions made by the Examiner regarding the rejection of dependent claims 2, 5-11, 13-18, and 22-25 under 35 U.S.C. § 103(a), Applicant submits that dependent claims 2, 5-11, 13-18, and 22-25 are allowable for at least the reason that they depend from allowable claims 1.

5. New Claims

Applicant has added new dependent claims 26-28. Applicant submits that dependent claims 26-28 are allowable for at least the reason that they depend from allowable claim 1.

6. Conclusion

Applicant believes that all of the pending claims have been addressed in this response. However, failure to address a specific rejection or assertion made by the Examiner does not signify that Applicant agrees with or concedes that rejection or assertion.

For the foregoing reasons, Applicant submits that claims 1-2, 5-11, 13-18, 20, and 22-28 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all the pending claims.

Respectfully submitted,

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Dated: March 26, 2008

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